

### REMARKS

In the Office Action mailed 4/4/2010, Claims 2-6 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 2 and 4 were rejected as being obvious over the prior art under 35 U.S.C. § 103.

Claims 3 and 5-6 were objected to, but were indicated as containing allowable subject matter.

In response, Applicant has herein made amendments to Claims 1-6 in order to clarify scope of the claimed method, and to overcome the Examiner's indefiniteness rejections. Applicant has further added new claims 16 – 22. No new matter has been entered. Applicant respectfully asserts that the claims, as amended, are now in condition for allowance for the reasons set forth below.

#### Patentability of Claims 1-6 (as amended)

These claims stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of AAPA and Illegems. Applicant respectfully traverses the rejection of these claims for the reasons set forth below after a discussion of the teachings of these references.

#### Applicant's Admitted Prior Art (AAPA)

The Examiner has relied in part upon Applicant's Admitted Prior Art as a basis for rejecting Applicant's claims as being obvious. As depicted in Applicant's Figure 1, as originally filed, the AAPA does not suggest any IEEE 1394 transceiver having the ability to

automatically control its power consumption in response to the existence (or lack) of an effective bus connection with another firewire device.

**Illegems, U.S. Patent Publication No. 2004/0012449**

Illegems is a “Ring Oscillator with Frequency Stabilization.” The Illegems device is a “current-controlled ring oscillator” that “uses a single controlled-current supply for supplying current to each inversion stage of the ring oscillator.” *see Abstract*. The Examiner relies upon Illegems for the proposition that the use of a temperature-controlled frequency generator is known. While the Illegems oscillator may arguably contain similarities to the “internal oscillator 50” of Applicant’s invention, there is nothing in Illegems to suggest the use of the Illegems oscillator within a “firewire” transceiver to assist in enabling the firewire transceiver to function in a low-power standby mode. Illegems further fails to suggest a transceiver circuit or method having a conventional oscillator coupled to the current-controlled, temperature-compensating oscillator for calibration thereof when shifting from low-power demand to high-power demand states.

**Independent Claim 1 (as amended)**

Applicant’s independent Claim 1, as amended, recites:

“An IEEE1394 tone transmission method in beta mode comprising:

adjusting the internal power consumption level of an IEEE 1394 transceiver’s transmitter responsive to an external cable being attached to said transceiver, said adjusting conducted by a controller for automatic adjustment of power consumption level

of the device responsive to whether or not an effective bus connection has been made by said external cable;

wherein a self-calibrated oscillator, a "tone" transmitter, a "tone" receiver, and termination circuitry are all responsive to said controller<sup>1</sup>."

The amendments to this (and Claims 2-5) were made in order to resolve the Examiner's indefiniteness rejections. If the method language of this claim, as originally filed, was indefinite, Applicant has resolved such indefiniteness through the instant amendment. The claim, as amended, is well-disclosed by the Specification as originally filed, and therefore no new matter has been entered.

**The Examiner has failed to make out a Prima Facie Case of Obviousness under 35 USC §103**

As is well-settled, a prima facie case of obviousness is established only when the Examiner provides:

1. one or more references<sup>2</sup>
2. that were available to the inventor<sup>3</sup>
3. where the reference(s) teach<sup>4</sup>

<sup>1</sup> *AAPA* fails to suggest an operational method related to switching between different power modes responsive to a bus connection being made. In fact, as is discussed at length in the original specification, the reduction of the power consumption of the IEE1394 transceiver is the main objective of the claimed method - excessive power use is the problem sought to be solved by the invention. While *Illegems* may teach a current-controlled oscillator, there is nothing to suggest that the *Illegems* device be used in the context of a power-conserving firewire transceiver.

<sup>2</sup> *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

<sup>3</sup> See *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

<sup>4</sup> *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964)).

4. a suggestion to combine or modify the reference(s) <sup>5</sup>
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. <sup>6</sup>

If the Examiner fails to produce a *prima facie* case of unpatentability, "then without more the applicant is entitled to the grant of the patent."<sup>7</sup>

Here, neither AAPA, nor Illegems, either alone or in combination, teach or otherwise suggest a method for IEEE 1394 tone transmission in beta mode that automatically adjust the transceiver power consumption responsive to the presence or lack of an effective bus connection. Even if these references are related to the field of IEEE1394 communications, there is nothing in either to suggest the management of power demand for such a transceiver.

Since there is no suggestion in either AAPA or Illegems that would appear to make the claimed invention obvious to one of ordinary skill in the art of IEEE1394 communications, the *prima facie* case of obviousness fails, and this ground for rejection must be withdrawn.

#### **Dependent Claims 2-6 (as amended)**

These claims depend from independent Claim 1, and as such, necessarily incorporate additional limitations or elements as compared thereto. Since Claim 1 is not obvious in view of the cited references, as discussed above, these dependent claims also cannot be obvious.

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<sup>5</sup> *In re Lahu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

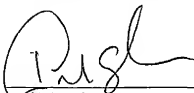
<sup>6</sup> *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 47 USPQ 2d 1027, 1033 (Fed. Cir. 1998).

**Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue.

Respectfully submitted,

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A handwritten signature in dark ink, appearing to read 'Karl M. Steins', written over a horizontal line.

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<sup>7</sup> *In re Oetiker*, 977 F.2d 1444, 24 USPQ 2d 1444 (Fed. Cir. 1992).